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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,015	12/29/2000	Peter Perthou	08914-009001	1179
26161 7590 08/18/2008 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
BARRETT, SUZANNE LALE DINO				
ART UNIT		PAPER NUMBER		
3673				
MAIL DATE		DELIVERY MODE		
08/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/752,015

Applicant(s)

PERTHOU, PETER

Examiner

Suzanne Dino Barrett

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 3,5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Design Patent No. D435,720.

An "obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that 'the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa'". *In re Dembiczak*, 175 F.3d 994, 1002 (Fed. Cir. 1999), quoting *Carmen Indus., Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983). "In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, the design characteristics of which are 'basically the same as the

claimed design". *Dembiczak* at 1002, quoting *In re Borden*, 90 F.3d 1570, 1574 (Fed. Cir. 1996). Thus, for a utility patent application claim to render obvious a design patent claim, the utility patent application claim must indicate design characteristics that are basically the same as the claimed design. See *Dembiczak* at 1002.

The Appellant's claim 1, which is the sole independent claim among claims 1, 2, 4 and 6-10, recites "a key-holding ring". In view of that recitation, one of ordinary skill in the art would have envisaged the most basic of key-holding rings, i.e., the simple spiral round wire key-holding ring shown in Perthou's figures that has been ubiquitous for generations.

The Appellant's claim 1 recites "a band". In view of that recitation, one of ordinary skill in the art would have envisaged the simplest of bands, i.e., the simple, plain, rectangular band shown in Perthou's figures.

The Appellant's claim 1 recites "a D-ring coupling said band to said key-holding ring, said D-ring having a U-shaped portion engaging the key-holding ring and a bar between the ends of the U-shaped portion and engaging the band". That description describes the D-ring in Perthou's figures. In view of that recitation, the engagement between the D-ring and the key-holding ring that would have been envisaged by one of ordinary skill in the art would have been the conventional engagement, i.e., each ring passing through the opening in the other ring as shown in Perthou's figures. In view of that recitation, one of ordinary skill in the art

would have envisaged the simplest engagement between the bar and the band, i.e., the band looped around a bar of the same width as the band as shown in Perthou's figures.

Moreover, during patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the Specification, as the claim language would have been read by one of ordinary skill in the art in view of the Specification, *see In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Therefore, the Appellant's terms "key-holding ring", "band" and "D-ring" would have been construed by one of ordinary skill in the art as including those in the Appellant's figures 1-5, which are the same as those required by Perthou's claim.

Perthou's claim, however, as shown in the figures, requires what appears to be a clamp at the end of the band opposite the D-ring. The Appellant's Specification indicates that what appears to be a clamp in Perthou's figures is a clamp (Spec. 3:5-9), but the clamp is not recited in claim 1, its dependent claims 2, 4, 6, 7 and 9, or independent method claim 11. Thus, the Examiner has not established that the recitations in those claims are sufficient to have rendered Perthou's design patent claim *prima facie* obvious to one of ordinary skill in the art.

Also, the Appellant's claims 6-11 require a gap in the D-ring's bar. That gap is not shown in Perthou's figures. The Examiner has not explained, and it is

not apparent, how Perthou's claim which lacks the appearance of a gap would have rendered the gap required by the Appellant's claims 6-11 *prima facie* obvious to one of one of ordinary skill in the art.

Claims 3 and 5

Claim 2, from which claim 3 depends, recites that the band is a web of material having ends looped through the D-ring and joined at the ends. That recitation describes the band and looping engagement between the band and the D-ring shown in Perthou's figures. Claim 3 recites that there is a clamp at the ends of the web. In view of that recitation, one of ordinary skill in the art would have envisaged the simplest of clamps, i.e., the simple piece of material the same width as the band folded over the ends of the band as shown in Perthou's figures. Moreover, during patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the Specification, as the claim language would have been read by one of ordinary skill in the art in view of the Specification, *see Zletz*, 893 F.2d at 321, 13 USPQ2d 1320; *Sneed*, 710 F.2d at 1548, and the clamp shown in the Appellant's figures 1-5 is the same as that shown in Perthou's figures 1-5. Hence, the Appellant's term "clamp", when most broadly construed by one of ordinary skill in the art in view of the Appellant's Specification, would have included Perthou's clamp.

Therefore, Perthou's claimed design would have been *prima facie* obvious to one of ordinary skill in the art in view of the Appellant's claim 3.

Conversely, as indicated above, Perthou's claimed design, as shown in the figures, includes a component falling within each limitation recited in the Appellant's claim 3. The invention claimed in the Appellant's claim 3, therefore, at least would have been prima facie obvious to one of ordinary skill in the art over Perthou's claim.

The Appellant's claim 5, which depends from claim 3, recites that the clamp width is substantially the same as the width of the band. Thus, claim 5 recites, regarding the relative widths of the clamp and the band, what one of ordinary skill in the art would have envisaged, as pointed out above, given the recitation in claim 3. Therefore, for the reasons given above regarding claim 3, the invention claimed in the Appellant's claim 5 would have been prima facie obvious to one of ordinary skill in the art over Perthou's claim, and vice versa.

Because, as discussed above, the inventions claimed in the Appellant's claims 3 and 5 would have been prima facie obvious to one of ordinary skill in the art over Perthou's claim and vice versa, the inventions claimed in the Appellant's claims 3 and 5 would have been prima facie obvious to one of ordinary skill in the art under the doctrine of obviousness-type double patenting.

The Appellant argues that "[a] device could be constructed that would infringe the claims of the utility patent [application] but not the very narrow claim of the design patent" (Br. 4).

The Appellant's claims 3 and 5 encompass structures other than that in Perthou's claim. However, Perthou's claimed design is the simplest, most utilitarian of designs, i.e., a simple D-ring having the bar and U-shape recited in the Appellant's claim 1, the simplest of bands (a plain rectangular band) engaged with the D-ring in the simplest of ways, i.e., looped over the D-ring's bar, a simple spiral round wire key-holding ring engaged with the D-ring in the simplest of ways, i.e., looping engagement, and the simplest of ways for attaching together the sides of the loops, i.e., a simple clamp comprising a piece of material the same width as the band folded over the end of the band. Because Perthou's design is the simplest, most utilitarian of designs, that design would have been envisaged by one of ordinary skill in the art given the recitations in Appellant's claims 3 and 5. Also, as pointed out above, because the Appellant's claim terms are construed in view of the Appellant's Specification, the drawings of which show Perthou's design, one of ordinary skill in the art would have construed the Appellant's claim 3 and 5 as including Perthou's design.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1,6,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,069,050 in view of Jung 4,903,514, and Momemers 4,523,443.

5. Chen discloses a separable key holder comprising a pair of elongated, preferably flexible and rectangular straps (16, 18), most of one surface of each strap having thereon a patch of hook and loop fastening material (20 or 22) for releasable attachment to the comparable hook and loop fastening material of the other strap (col. 3, 11. 19-25, 35-39). An end of each strap is free of hook and loop fastening material, passes through a circular key holding element (12 or 14), and is folded back upon itself and sealed to itself, preferably by heat sealing, so as to hold the key holding element in looping engagement with the strap (col. 3, 11. 41-54; figs. 1, 2).

Jung discloses a combined nail clipper and key holder comprising an elongated nail clipper container (11), a triangular-shaped connecting member (14), one side of which has a gap in its central portion with a prong on each side of the gap that extends into nail clipper container 11 for fastening connecting member 14 to nail clipper container 11, and a key ring (15) in looping engagement with connecting member 14 (col. 2, 11. 18-22, 45-50; figs. 1, 3).

Momemers discloses a key keeper comprising a D-shaped loop (3) having a U-shaped portion and, between the ends of the U-shaped portion, a bar having a gap (17) therein for receipt of keys onto loop 3 (abstract; col. 2, 11. 39-41; fig. 1). On each side of the gap is a leg (15 or 16) that projects into a cavity in a loop holder (2) (col. 3, 11. 44-47; fig. 1).

The Appellant questions the desirability of combining the references to arrive at the claimed invention (Br. 4-7; Reply Br. 2-3).

As stated by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41 :

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Chen's key holding elements 12 and 14 are attached directly to straps 16 and 18 without an intervening ring (figs. 1, 2). However, Jung's disclosure of connecting member 14 (col. 2, 11. 45-47) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use an intervening ring in Chen's key holder to provide the readily apparent benefits of rendering the key holding element attachment releasable and permitting multiple key holding elements to be attached to each strap. See *KSR*, 127 S.Ct. at 1741 (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ").

Jung's connecting member 14 is not D-shaped. However, Jung does not set forth any significance of the shape of connecting member 14, other than indicating

that it must have a bar comprising inwardly extending prongs with a gap therebetween for attaching connecting member 14 to clipper container 11 (figs. 1, 3). Hence, one of ordinary skill in the art would have been led, through no more than ordinary creativity, to use other shapes that provide inwardly extending prongs, such as Momemers's D-shaped loop 3 (fig. 1).

Although Momemers's loop 3 is a key-retaining loop rather than a connecting member (abstract), one of ordinary skill in the art would have appreciated that the gap in Momemers's loop that is suitable for receiving keys (col. 3, 1.42) also would be suitable for receiving a key ring. As stated by the Supreme Court in *KSR*, 127 S.Ct. at 1740, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

Regarding claim 11, Chen's key-holding elements 12 and 14 are attached to straps 16 and 18 preferably by heat sealing, and alternatively by stitching (col. 3, 11. 50-53), not by passing the ends of straps 16 and 18 through a gap in key-holding elements 12 and 14. However, one of ordinary skill in the art would have been led, through no more than ordinary creativity, by Momemers's disclosures that key-retaining loop 3 has a bar with a gap (abstract; fig. 1) and that keys can be inserted through the gap (abstract; col. 3, 1. 42; fig.1), to attach Chen's straps 16 and 18 through a gap so that straps 16 and 18 can be releasably attached to the D-ring of the combined disclosures of Chen, Jung and Momemers, and so that the loops at

the ends of the straps can be formed in advance by heat sealing or stitching and later attached to key-holding elements 12 and 14.

6. Claims 2,4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jung and Momemers, as applied to claim 1 above, and further in view of Miller 1,704,137.

7. Miller discloses a key holder comprising a strip of material, preferably leather, that is folded over at an end to form a loop through which a key chain passes, is closed by stitching (16) at the other end, and has one snap fastener (28) at each of its side edges intermediate the fold and stitching 16 to fasten together the side edges (p. 1, 11. 32-57; fig. 3).

The Appellant argues that the applied references do not suggest the desirability of the limitations in the Appellant's claims 2, 4, 7 and 9 (Br. 9).

Regarding claim 2, Chen discloses a web (straps 16, 18) looped through key-holding elements 12 and 14 (col. 3, 11. 19-25; figs. 1, 2). Attaching a D-ring to straps 16 and 18 would have been obvious to one of ordinary skill in the art for the reasons given above regarding the rejection of claims 1, 6 and 11. Like the Appellant's D-ring, that D-ring would have the ability to rotate through an angle of nearly 360 degrees and would permit rotation of a key-holding ring looped with it to ride along the inside of its U-shaped inside portion for substantially 180 degrees as required by the Appellant's claim 4.

With respect to the requirement of claims 7 and 9 that the key-holding ring is a spiral ring, Chen discloses in figure 4 what appears to be a conventional spiral key ring (12). Also, Jung discloses what appears to be a conventional spiral key ring (15) (fig. 1), and Chen's disclosure of a key holding ring (col. 3, 11. 19-20; figs. 1, 2) would have led one of ordinary skill in the art, through no more than ordinary creativity, to use as the ring any known key holding ring such as the apparently-conventional spiral ring disclosed by Jung.

Response to Arguments

8. Applicant's arguments filed 7/7/08 have been fully considered but they are not persuasive. As set forth in the Board decision of 5/5/08, the Chen, Jung, Momemers and Miller patents teach the claimed key holder. Furthermore, the double patenting rejection of claims 3 and 5 in view of Perthou design patent also stands. Applicant's amendments do not overcome the new grounds of rejection set forth in the Board decision. Accordingly, claims 1-6,11 stand rejected.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Suzanne Dino Barrett

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Primary Examiner
Art Unit 3673

sdb
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